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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,845	09/28/2001	Barbara J. Boe	065027.0103	4972

5073 7590 06/18/2007

BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

EXAMINER	
RETTA, YEHDEGA	
ART UNIT	**PAPER NUMBER**
3622	

NOTIFICATION DATE	DELIVERY MODE
06/18/2007	ELECTRONIC

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mike.furr@bakerbotts.com
ptomail1@bakerbotts.com

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/966,845
Filing Date: September 28, 2001
Appellant(s): BOE ET AL.

Charles S. Fish
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 26, 2007 appealing from the Office action mailed September 6,2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,999,918	WILLIAMS et al.	12-1999
6,925,441	JONES, III et al.	8-2005
5,848,397	MARSH et al.	12-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed May 31, 2006. Claims 1, 10, 15, 20 and 23 have been amended. Claims 1-28 are still pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 11-19, 22, 26 and 27are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Williams et al. (US 5,999,918).

Regarding claim 1, Williams teaches storing data associated with the responses to customer questions (see fig. 6a-6e and col. 14 line 62 to col. 15 line 12); providing the customer with a feedback page, graphically illustrating data associated with the customer's standing in a *selected peer group associated with the customer* (group of people sharing the same or similar demographics; same age, same income, same goal) (see fig. 1h and col. 15 line 45 to col. 16 line 19); providing the customer with options operable to adjust the customer's actual demographic to a hypothetical demographic; receiving and processing the data and displaying feedback information, graphically illustrating hypothetical standing of the customer within the selected

peer group such that the customer can see the effect of the hypothetical demographic changes (see fig. 1i-1l, col. 9 line 5 to col. 10 line 32 and col. 16 lines 14- 49).

Regarding claims 2-7, Williams teaches wherein the customer questions comprise a primary set of question and secondary set of questions; wherein the primary set of questions relates to customer's demographic including personal information about the customer; wherein the secondary set of questions forms a plurality of survey sections related to business products or customer's psychographic traits; question provided based on response to previous questions; feedback page generated based on the customer responses , etc, (see fig. 6a-6e, col. 9 line 36 to col. 10 line 12).

Regarding claims 8 and 9, Williams teaches presenting the customer with online option associated with an opportunity to gain pertinent information related to and apply for a purchase products or services; sending a message to a business offering the products or services regarding the request for the product or services (see col. 10 lines 1-59).

Regarding claim 11, Williams teaches providing a business where the customer is identified as a particular existing customer of the business (see fig. 6 enrollment).

Regarding claims 13 and 14, Williams teaches providing goal planners to the customer; wherein the planners include output graphics that change in real time in response to changes in the input of the goal planners (fig. 1a-1j).

Regarding claims 16 and 17, Williams teaches wherein customer question provided is chosen based on response to previous questions; feedback page generated based on the customer responses (see fig. 6a-6e, col. 9 line 36 to col. 10 line 12).

Regarding claims 18 and 19, Williams teaches presenting the customer with online option associated with an opportunity to gain pertinent information related to and apply for a purchase products or services; sending a message to a business offering the products or services regarding the request for the product or services (see col. 10 lines 1-59).

Regarding claim 22, Williams teaches the system further operable to generate data sets for display based on data accessed in at least one table wherein the data assessed by the system is associated with the specific business or customer (see col. 9 line 5 to col. 10 line 23).

Regarding claims 26 and 27, Williams teaches receiving goal input data form the customer and storing the input data (see col. 9 lines 5-35, col. 11 line 21 to col. 12 line 23).

Claim Rejections - 35 USC § 103

Claims 10, 12, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (US 5,999,918) further in view of Official Notice.

Regarding claims 10 and 20, Williams teaches customer identification number (name) and matching the number to a data, however failed to teach matching a business identification number to a data and generating data sets for display based on the data in the table. Williams teaches the system being connected to remote computer located at the site of brokerage firm authorized to accept and execute securities transactions for the users of the present invention and the remote computer in communication with various stock exchange computers (see col. 10 lines 50-59). It would have been obvious to one of ordinary skill in the art at the time of the invention for Williams' system to receive the business identification (such as name or number i.e., brokerage firm or stock exchange system) and matched it to the stored data based for the purpose

of identifying the brokerage firm used by the user. ***(See Hawkins (US5497317) col. 5 line 55 to col. 6 line 35, Gerace (US 5848396 col. 7 line 39 to col. 8 line 12, Snelling (US 5,826257) abstract, col. 2 lines 28-56, col. 3 lines 16-42).***

Regarding claims 12 and 21, Williams does not teach providing percentage completion and data of the most recent visit to the survey. Official notice is taken that is old and well known in the art of collecting data to provide percentage of completed question ant the date of the last visit. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such information for the purposed of informing the user whether he/she wants to complete or update the profile ***(see Hondros et al. (US 6,263,439) fig. 6-15).***

Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, III et al. (US 6,925,441) further in view of Marsh et al. (US 5,848,397).

Regarding claim 23 Jones teaches a business interface operable to interact with a data processing system associated with a business; a customer interface operable to interact with a data processing system associated with a customer (see fig. 4); a survey system operable to supply the business data processing system with a targeted marketing reports, the targeted marketing reports dynamically generated based on a set of decision rules, the set of decision rules (see col. 13 line 19 to col. 14 line 8) dynamically generated based on data received from the customer (see fig. 7-11, fig. 14, col. 6 line 38 to col. 7 line 45, col. 9 line 7-58). Jones teaches an integrated database comprises demographic, credit, transactional, lifestyle preferences, and response-to-offers history of a wide variety of consumers. The neutral agent selecting superior product offers targeted to the individual consumer based on his demonstrated purchase behavior of all observed products and services, and the consumer's economic and

demographic characteristics (see col. 4 lines 40-55, col. 9 lines 55-58). Jones failed to explicitly teach the demographic data being received directly from the consumer, it is taught in Marsh. Marsh teaches the advertisement distribution scheduler used to target advertisements to particular users based on demographic information stored in a database management system, the demographic information obtained by having a user complete a survey (directly from the consumer). Marsh also teaches the profile including such information as the user's hobbies, interests, employment, education, sports, age and gender (see col. 3 lines 12-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to receive the customer data directly from the consumer (through survey). One would be motivated to include a survey in Jones targeted marketing for the intended purpose of collecting user's demographic data, such as user interests, preference, etc, as taught in Marsh.

Regarding claim 24, Jones teaches wherein the targeted marketing reports comprise of probability associated with at least one customer regarding the likelihood that the customer will purchase a specific product or service (see col. 9 lines 33-55).

Regarding claim 25, Jones teaches the system further operable to generate targeted advertisements for each customer based on data in the targeting marketing reports (see col. 15 line 1 to col. 16 line 36).

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (US 5,999,918) further in view of Jones, III et al. (US 6,925,441).

Regarding claim 28, Williams does not teach the system operable to generate targeted advertisements for each customer based on data received form the customers, it is taught in Jones (see col. 15 line 1 to col. 16 line 36). It would have been obvious to one of ordinary skill in the

art at the time of the invention to provide generate targeted advertisements for intended purpose of providing the customer with products or services that is likely to purchase.

(10) Response to Argument

Appellant argues that there is no showing in fig.1h and 6b of how the individual stands within any group let alone a selected peer group associated with the individual user. Examiner would like to point out that Examiner cited fig. 1h and **col. 15 line 45 to col. 16 line 19** and also fig. **1i-1l, col. 9 line 5 to col. 10 line 32 and col. 16 lines 14- 49**. Williams discloses, "a graphic depiction of portfolio returns showing absolute returns, and comparisons to bench-marks is shown". Williams further teaches in a preferred embodiment, the user is able to see **how his or her recommended (or actual) portfolio compares to others** (see col. 15 line 65 to col. 16 line 4). Fig. 1h shows entering different data to see the outcome. For example if an individual enters data with starting with a zero saving, starts saving at the age of 41, and retires at the age of 66 then the retirement savings is shown to be $146,211. The graph shows not just the outcome for the individual user but for anyone between ages 41 and 90 (peer group). William also shows the option to adjust the contribution to have different outcome. If the user in William changes the starting age to for example 35 (hypothetical age) or the yearly saving (hypothetical), the graph would include the outcome (different savings) for age 35 to age 90, same as appellant's disclosure (see appellant's fig. 4c).

Regarding claims 10, 12, 20 and 21, Appellant in response to the final rejection stated that claims 10, 12, 20, and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Williams, et al. in view of Official Notice. Independent Claim 1, from which Claims 10 and 12 depend, and Independent Claim 15, from which Claims 20 and 21 depend, have been shown

above to be patentably distinct from the Williams, et al. patent. Appellant in the argument stated "*In addition, Applicant respectfully requests the Examiner to cite documentation to support the taking of Official Notice in this rejection. The Examiner has stated that the cited features of Claims 12 and 21 are well known in the art but there has been no showing by the Examiner that the cited features were well known at the time of the claimed invention*". Appellant in the Appeal Brief states, "*The Examiner has yet to cite any documentation to support the taking of Official Notice in this rejection. The Examiner has stated that the cited features of Claims 10, 12, 20, and 21 are well known in the art but there has been no showing by the Examiner that the cited features were well known at the time of the claimed invention*".

Examiner indicates that Claims 10 and 20 recite:

a business identification number and a customer identification number;

match the business identification number with data in at least one table;

match the customer identification number with data in at least one table; and

generate data sets for display based on the data in the at least one table.

Even though the claim recites matching a business identification number with a data in a table, the data sets generated for display is based on data in any table, which has nothing to do with the matching. Nor has anything to do with the customer identification number or customer identification number. Williams teaches customer identification (name) and matching it with a data in a table (profile database) and generating data sets (investment or portfolio, see col. 11 line 1-13) for display based on data in the at least one table (data in any table) (see col. 11 lines 32-59). William teaches the remote computer located at the site of brokerage firm authorized to accept and execute securities transactions for the users of the present invention, but failed to

explicitly teach matching the business (brokerage) identification to a database or table. Examiner took official notice to the step of matching business identification number with data in at least one table (business database) and stated that "It would have been obvious to one of ordinary skill in the art at the time of the invention for Williams' system to receive the business identification (such as name or number i.e., brokerage firm or stock exchange system) and matched it to the stored data based for the purpose of identifying the brokerage firm used by the user".

Claims 12 and 21 recite wherein the survey system is further operable to provide percentage completion and date information to the customer based on the percentage of the customer questions that have been answered by the customer and the date of the most recent visit to the survey system by the customer.

Examiner would like to point out that Official Notice was taken to the limitation that are considered to be notoriously well known to one of ordinary skill in the art at the time of applicant's invention was made, i.e., the step of matching an identification number to a database or table or providing percentage of completion of a questionnaire. Appellant's response to the Official Notice has not provided adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Therefor, the presentation of a reference to substantiate the Official Notice is not deemed necessary. The bold statement provided by the Applicant is not adequate and do not shift the burden to the examiner because such statement to challenge the Official Notice would effectively destroy the purpose of using official notice to establish a rejection of a very well known facts.

However, assuming arguendo, Examiner provides the above indicated prior art, to support the well-known features.

Regarding claims 23-25 Appellant argues that the Examiner has not established that any criteria for a prima facie case of obviousness has been met in this instance. Appellant asserts that first there is no suggestion or motivation in the Jones III, et al. patent or the Marsh, et al. patent to combine them as proposed by the Examiner and the Examiner has failed to show that there is some teaching, suggestion, or motivation to combine the Williams, et al. patent and the Jones III, et al. patent as proposed. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Appellant also argues that the Jones III, et al. patent is directed to a system and method of targeted marketing to provide incentives to a purchaser for loyalty reinforcement based on information gathered indirectly about the purchaser and the Marsh, et al. patent is directed to a technique for scheduling the presentation of messages to computer users based on user gathered information. In response to appellant's argument that the prior art is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both reference are related to profiling or collecting demographic data. As stated before Jones teaches storing purchase

behavior of all observed products and services, and the consumer's economic and demographic characteristics, however failed to indicate it was received directly from the consumer, Marsh was introduced for the teaching of collecting demographic data through survey as disclosed and claimed by Appellant.

Appellant also argues that the Examiner has not shown that the proposed Jones III, et al. - Marsh, et al. combination teaches or suggests all of the claim limitations. Appellant argues that the Jones III, et al. patent fails to receive data directly from customers as required in the claimed invention and the Jones III, et al. patent does not discuss the use of decision rules being used to generate the targeted marketing reports let alone decision rules being generated based on customer data as required by the claimed invention and the Marsh, et al. patent fails to disclose the use of decision rules to generate the targeted marketing reports.

Appellant's specification discloses "According to one embodiment of the present invention, input data for the statistical processing program may be retrieved by survey system 12 from matching database 24 and may comprise the business identification number, the specific product or service (dependent variable), customer identification numbers, customer demographics (attributes), and customer responses (attributes). The statistical processing program may then segment the data and predict probabilities of purchase. This may be accomplished by detecting the influence of attributes on the dependent variable, modeling continuous and non-continuous data and missing data, detecting statistically significant differences among groups of customers, merging non-significant groups of data, and creating decision rules". The specification does not teach what the decision rules.

Regarding the decision rules Jones teaches for example the content provider might provide personal loans to consumer of high net worth who have good credit ratings (see col. 6 lines 52-65), which is a decision rule.

Appellant also argue that the Marsh, et al. patent also fails to disclose the use of the survey information for generating decision rules that are used for generating the targeted marketing reports. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

RETTA YEHDEGA
PRIMARY EXAMINER

Conferees:

Eric Stamber

Raquel Alvarez